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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,375	06/22/2001	Shin-Ichi Kumamoto	TPP 30565A	7004

7590

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EXAMINER

PASTERCZYK, JAMES W

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 08/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

Office Action Summary

Application No.
09/886,375

Applicant(s)
Kuramoto et al.

Examiner
J. Pasterczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/22/01, 10/2/01, 11/30/02, 8/5/03
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-50 is/are pending in the application.
- 4a) Of the above, claim(s) 46-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 30-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/260,540.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2,4,5
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 7
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Interview Summary

Application No.
09/886,375

Applicant(s)
Kuramoto et al.

Examiner
J. Pasterczyk

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All participants (applicant, applicant's representative, PTO personnel):

(1) J. Pasterczyk

(3) _____

(2) Thomas Pavelko, Esq.

(4) _____

Date of Interview Aug 5, 2003

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy is given to 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No. If yes, brief description:

Claim(s) discussed: 30-50

Identification of prior art discussed:

non

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Oral restriction requirement was made between claims 30-45 vs. 46-50; applicants elected claims 30-45 with traverse.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 30-45, drawn to a process for producing a catalyst, classified in class 502, subclass 116.
- II. Claims 46-50, drawn to a catalyst with enumerated atomic components with a particular surface area, classified in class 502, subclass 118 et seq.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as depositing metallocene solutions upon magnesium halide supports in the presence of electron donor compounds.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Thomas Pavelko, Esq., on 8/5/03, a provisional election was made with traverse to prosecute the invention of group I, claims 30-45. Affirmation of this election must be made by applicant in replying to this Office action. Claims 46-50 are

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The abstract of the disclosure is objected to because it refers to chemical groups by Roman numerals, which is obsolete terminology, as well as purported benefits of the invention and an invention cancelled in preliminary amendment. Correction is required. See MPEP § 608.01(b).

7. Claims 30-45 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the process being used to make Ziegler-Natta catalysts, does not reasonably provide enablement for making e.g. metallocene catalysts which also may have the components recited in them. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The claims are very broad by reciting the components in them by only atomic identity, function, i.e. electron donor, or functional group, i.e. hydrocarbyloxy group, hence there appears to be no further limitation placed on the identities of the actual chemical compounds which may provide these species.

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8. Claims 30-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 30, 31, 37, 38, 39 and 45 use both the obsolete Roman numeral terminology to refer to chemical groups as well as the current Arabic numeral terminology; the Roman numeral terminology is ambiguous since it is not clear if the American or British system is being used, hence it is suggested that the Roman numerals be deleted entirely.

In claim 30, the last seven lines after “wherein” are prolix since they do not limit the process as claimed and are not part of it. Also, “(2)” should be after the formula in the fourth line from the end.

In claim 31, penultimate line, change the last “a” to --the--.

Claims 35 and 36 fail to further limit claim 30 from which they depend since claim 30 recites a process comprising a step, while claims 35 and 36 purport to limit the composition on which the process is practiced, yet they do not limit the process itself by actually reciting additional steps. Claim 36 also does not end with a period.

In claim 37, l. 5-12 after “wherein” is prolix since it does not limit the claimed process and is not part of it. Likewise with claim 45, l. 4-12.

In claim 38, from l. 3 “the intermediate . . .” onward is prolix since it does not limit the process by adding new steps; in fact, only one step is recited in l. 2.

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Claim 39 fails to further limit claim 38 from which it depends since it recites nothing about the process claimed in claim 38. Likewise with claims 40-44. In l. 5 of claim 38 the last "a" should be --the--.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 30-34 and 37 rejected under 35 U.S.C. 102(b) as being anticipated by Matsuura et al., USP 4,822,763 (hereafter referred to as Matsuura I).

Matsuura I discloses the invention as claimed (example 1, col. 11-12).

12. Claims 38 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsuura et al., USP 4,617,284 (hereafter referred to as Matsuura II).


Matsuura II discloses the invention as claimed (example 1, col. 8-9).

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is (703) 308-3497. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for normal faxes, 872-9311 for after final faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700



J. Pasterczyk

AU 1755

8/6/03